

Remarks

Claims 1-11 are pending.

Distinguishing Trevino and Sanders (Claims 1, 5 and 6)

Claims 1, 5 and 6 were rejected under Section 103 as being obvious over Trevino 6067678 in view of Sanders 6378149.

Claim 1 recites an infant holder that includes a body having a recess therein configured to support an infant's torso and legs such that the thighs extend out from the torso at an angle in the range of 70°-120° and incline relative to the torso at an angle in the range of 20°-50°. Claim 6 recites similar limitations.

Trevino shows and describes a recessed and contoured foam infant holder that supports an infant in a slightly inclined position with the legs extending straight out from the torso. Trevino Figs. 8 and 9. The Examiner asserts that Sanders teaches "a holder similar to that of Trevino ... configured to support a user's torso and legs such that the thighs extend out from the torso at an angle in the range of 70°-120° ... and incline relative to the torso at an angle in the range of 20°-50°...." As detailed below, the Examiner's characterization of Sanders seems a bit overstated.

The "radiolucent split leg accessory for a surgical table" shown and described in Sanders is really not the least bit similar to the infant holder shown and described in Trevino. Sanders teaches a flat surgical table in which that portion of the table supporting the legs is hinged so that each leg support may be rotated up and down and/or in and out. Sanders Figs. 3 and 4. Sanders does not teach a configuration in which the thighs extend out from the torso at an angle in the range of 70°-120°, nor does he teach a configuration in which the thighs incline relative to the torso at an angle in the range of 20°-50°. On the contrary, Sanders teaches only that each leg support is a movable through a range of angles vertically and horizontally -- he does not specify the desirability of any particular configuration.

Furthermore, the range of horizontal/lateral motion in Sanders does not fall within the 70°-120° range of Claims 1 and 6. Claim 1 recites that the "thighs extend out from the torso at an angle in the range of 70°-120°." Similarly, Claim 6 recites that each second portion (for supporting the legs) extends away from the first portion (for supporting the torso) at an angle in the range of 70°-120°. In Sanders, by contrast, the leg supports rotate horizontally/laterally through a range of motion in which the thighs extend out from the torso at an angle between 128°-180°. (Angles α and β in Sanders' Fig. 4 do **not** reflect the angle at which the thigh extends out

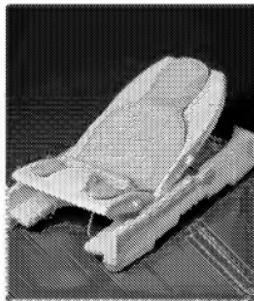
from the torso -- the supplementary angles to angles α and β reflect the angle at which the thigh extends out from the torso. Refer to angle 31 and Fig. 3 of the pending Application.)

Finally, Applicants respectfully submit that most of us non-gymnasts would find it difficult to endure a position on the Sanders surgical table in which his/her legs, held straight out, were bent back to within 120° of the torso, to say nothing of the risk of physical injury of continuing to an extension angle of only 70° (at any angle of inclination). At a minimum, such an awkward position would hardly be conducive to patient comfort.

There is just no good reason an ordinarily skilled artisan would look to Sanders to make improvements in, or modifications to, the contoured foam support of Trevino, especially not the infant holder version of Trevino's contoured foam support. And, in any event, modifying the contoured foam support of Trevino with the rotating leg supports of Sanders does not lead to the configuration recited in Claims 1 and 6.

Distinguishing The Stang Chair (Claims 1-11)

Claims 1-11 were rejected under Section 103 as being obvious over "www.noharm.org" in view of other references. The illustration at the noharm website cited by the Examiner, included in the Office Action as Diagram A, shows the Stang Circumcision Chair available from Pedicraft. The Stang chair is more clearly illustrated at the Pedicraft website (www.pedicraft.com/stangcircumcisionchair.html). The Pedicraft website also shows an infant seated in the Stang chair. These illustrations are reproduced below.



The Examiner states that the Stang chair "is basically the same as that recited in claims [1-11] except that the angle ranges of the torso and legs relative to the torso are not specified, as recited in the claims." Office Action page 3 (for Claims 1, 2, 5, 6 and 8) and page 5 (for Claims 3, 4, 7 and 9-11). This statement is fundamentally not correct.

Claim 1 recites a recess "configured to support an infant's torso and legs...." Claim 6 recites "second recessed portions for supporting the infant's legs...." Claim 10 recites "second leg recesses ... configured generally to support the infant's legs...." The Stang chair, by contrast, is not configured to nor does it support the infant's legs in general, and specifically not with a recess. This same issue was raised and resolved in the earlier appeal with regard to the Bowman reference previously cited. Decision on Appeal, pages 3-4. The Stang chair is not "basically the same as" the claimed infant holder. In fact, the Stang chair is fundamentally different from the claimed infant holder. If the Examiner disagrees, he is respectfully requested to specifically point out and explain those features of the Stang chair that might reasonably be interpreted as supporting the infant's legs. Absent such a showing, the rejections based on the Stang chair should be withdrawn.

Huggins teaches a recessed infant holder with the head below the legs and the legs extending straight out from the torso. Thus, so far as might be deemed relevant to the claimed subject matter, Huggins stands for the unremarkable proposition that recessed infant holders were known in the art.

Craig shows an infant held in a "hip splint device" in which the infant's thighs appear to be restrained relative to the torso in an orientation similar to that claimed. As with the Stang chair, however, Craig does not appear to support the legs (except, perhaps, at the point where the restraining straps are attached to the peg board) and, in any event, incorporating the Craig restraints into a recessed infant holder such as that shown in Huggins would render the Craig "hip splint device" ineffective.

Semmler shows and describes another contoured, recessed infant holder. But, again, Semmler does not include recesses configured to support the torso and legs as claimed.

Applicants respectfully submit that the real question of obviousness in this case is best articulated by the Examiner at pages 5-6 of the pending Action. There, the Examiner argues that the specific configurations recited in the claims reflect

"optimal workable ranges discovered by routine experimentation" and "an obvious matter of design choice..."

The Stang chair, like the Bowman reference previously cited, illustrates that if you lay an infant on its back, the legs will stick out from the torso in the manner shown. As the Applicants have noted in prior responses, the claimed infant holder takes advantage of this fact by providing features that support the infant in this natural position, specifically including the infant's legs. When the holder supports the infant in this natural position, the infant may be immobilized in this natural position. As noted in the Application at paragraph 0007, "[e]mbodiments of the invention are directed to an infant holder for circumcision and other medical procedures that helps an infant to lie in a natural, comfortable position with legs flexed at the hips and knees and rotated at the hips, while still allowing the doctor good access to the infant's groin area."

Thus, with regard to the "workable ranges" rationale, Applicants note that the novelty in the claimed subject matter is not so much a matter of routine experimentation as it is the startling realization that the infant's natural position informs rather than obstructs holding the infant in a desirable position for circumcision.

The question remains whether or not this realization reflects an obvious design choice. Of course, the absence of the development of the claimed infant holder over the course of the long history of the development of infant holders for circumcision and other surgical procedures suggests the new infant holder is not obvious. To the extent an infant's natural position might be deemed an "element" of the prior art, the Supreme Court recognized in KSR that it is important to identify a reason the ordinarily skilled artisan would combine elements from the prior art in the manner claimed:

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. KSR Int'l Co. v. Teleflex, Inc. 550 U.S.

_____, 127 S. Ct. 1727 (April 30, 2007) (pages 15-16 of the Bench Opinion).

This holding from KSR is reiterated in the Office's Examination Guidelines for Determining Obviousness in View of...KSR as follows:

When considering obviousness of a combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." Federal Register vol. 72, no. 195 October 10, 2007 p. 57527.

As detailed above, nothing in the prior art suggests **supporting** an infant in a natural position for circumcision and other surgical procedures despite the many, many years skilled artisans have been seeking more and improved ways to hold infants for such procedures. The improved infant holder reflected in the more broad claims would, therefore, seem to be more than the "predictable use of prior art elements according to their established functions." The more detailed elements of calf support, multiple recesses and the like recited in the more narrow claims seem undeniably to be much more than simply the predictable use of prior art elements.

All pending claims are felt to be in condition for allowance.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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